

REMARKS

Claims 23-74 are currently pending in the application. Claims 23, 43, and 56 currently amended to clarify the claimed subject matter(s) as embodied in these claims, without acquiescence in the cited basis for rejections or prejudice to pursue the original claims in a related application. No new matter has been added.

I. Rejections of Claims under 35 U.S.C. § 101

Claims 56-68 and 73-74 stand rejected under 35 U.S.C. 101 as allegedly being directed to non-statutory subject matter. More particularly, the final Office action alleges that “these system claims are rejected as non-statutory for failing to disclose any hardware. It is noted that the claimed processor could be interpreted as a software element which does processing and therefore the claim is non-statutory for not disclosing hardware.” Item #3, p. 2, December 09, 2008 final Office action. Applicants respectfully disagree.

A. Applicants also respectfully submit that 35 U.S.C. § 112, sixth paragraph, mandates that “such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof” “without the recital of structure, material, or acts in support thereof”. The Federal Circuit in *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), specifically stated that “[p]er our holding, the ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” (Emphasis added.) As such, Applicants respectfully submit that the basis for rejection of claims 22, 26, and 28 may be improper and thus respectfully

request withdrawal of rejections and reconsideration of these claims as mandated by 35 U.S.C. § 112, six paragraph.

Therefore, Applicants respectfully submit that 35 U.S.C. § 112, sixth paragraph, requires that the broadest reasonable interpretation of the means-plus-function limitation the examiner may give is statutorily mandated. Also, the final Office action's interpretation of processor to constitute only software means clearly and erroneously neglects the hardware / structure that is explicitly disclosed in the specification of the instant application.

B. Nonetheless, Applicants respectfully submit that claim 56 from which claims 57-58 and 73-74 depend is currently amended to recite "a display apparatus configured for displaying a result of the executing the document operation or a storage device or a tangible computer-readable memory for storing the result", without acquiescence in the cited basis for rejection or prejudice to pursue the original claims in a related application. Applicants respectfully submit that the current amendment to claim 56 renders the rejections under 35 U.S.C. § 101 moot.

As such, Applicants respectfully request withdrawal of the rejections and reconsideration of claims 56-68 and 73-74 for at least the foregoing reasons.

II. Claim Rejections - 35 USC § 102(e)

Claims 23-68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2004/0066529 by Wu et al. (hereinafter Wu.)

Without acquiescence in the cited basis for rejections or prejudice to pursue the original claims in a related application, claim 23 is currently amended to clarify the subject

matter and recites at least the following limitations. Claims 43 and 56 also recite similar limitations.

loading the collection partition into the computer-readable memory based on a result from the act of determining, wherein another collection partition and a data which is used to manage respective collection elements of the another collection partition and are removed from the computer-readable memory after a change in the another collection partition is stored in a second computer-readable memory after a change in one or more of the respective collection elements of the another collection partition is stored in a second computer-readable memory where there is insufficient space for loading the collection partition; and (emphasis added.)

Applicants respectfully submit that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described” MPEP § 2131 (emphasis added.) MPEP further mandates that “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim” and that “[t]he elements must be arranged as required by the claim” MPEP 2131 (emphasis added.)

A. Applicants respectfully submit that Wu does not disclose at least the claimed limitation of “another collection partition and . . . are removed from the computer-readable memory after a change in the another collection partition is stored in a second computer-readable memory”.

Wu discloses a “device for printing a document, such as an HTML document, in which data to be incorporated into an output image can be described in the form of reference to an outside source”. Abstract (emphasis added.) More specifically, Wu is merely concerned with “an image formation device for forming an image of a document the display content data of each document element of which must be acquired from outside the document.” ¶ [0011] (emphasis added.) That is, Wu is merely concerned with forming an

image of some display content data that is acquired from some external sources and printing the image of the display content data.

Nonetheless, Wu never disclose or even remotely suggests persisting any changes in the data of the collection partition prior to removing the collection partition from computer-readable memory. In fact, Applicants respectfully submit that it is highly unlikely that there would be any change in one or more of the respective collection elements of a collection partition is persisted by the “printing device” or “image forming device” as in Wu’s approach because Wu’s approach merely acquires display content data, forms an image, and prints the image.

Therefore, Applicants respectfully submit that Wu fails to disclose an identical invention as mandated by the current patent law jurisprudence and MPEP § 2131 and thus may not be used to preclude the patentability of claims 23-68 under 35 U.S.C. § 102(e) for at least the foregoing reasons.

B. Applicants further respectfully submit that Wu not only fails to disclose but in fact teaches away from at least the claimed limitations of “another collection partition and a data which is used to manage respective collection elements of the another collection partition and are removed from the computer-readable memory” (emphasis added.)

To the extent that the Examiner considers Wu’s “data to manage the display content data” in ¶ [0043] as disclosing the claimed limitation of “a data which is used to manage the another collection partition”, Applicants respectfully submit that Wu explicitly discloses in the same paragraph that “[i]n free the region, data to manage the display content data and a freed region in the RAM 103 is preserved, while the display content data itself is deleted after being saved in a different storage device” (Emphasis added.)

Therefore, Applicants respectfully submit that Wu teaches away from at least the aforementioned claimed limitation of “another collection partition and a data which is used to manage respective collection elements of the another collection partition are removed from the computer-readable memory after a change in one or more of the respective collection elements of the another collection partition is persisted in a second computer-readable memory where there is insufficient space for loading the collection partition” of claims 23, 43, and 56, and Wu thus may not be used to preclude the patentability of claims 23, 43, 56, and their respective dependent claims under 35 U.S.C. § 102(e) for at least the foregoing reasons.

III. Claim Rejections - 35 USC § 103(a)

Claims 69, 71, and 73 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of U.S. Patent No. 6,081,262 issued to Gill et al. (hereinafter Gill.) Applicants respectfully traverse.

The final Office action concedes that Wu does not disclose the claimed limitations of claims 69, 71, and 73 yet cites to Gill and alleges that Gill discloses these additional limitations of claims 69, 71, and 73. Applicants respectfully submit that regardless of whether or not Gill discloses these additional limitations, claims 69, 71, and 73 are believed to be allowable over Wu and Gill because of their dependency from the base independent claims 23, 43, and 56 and further because of the final Office action does not rely on Gill in supporting the basis for rejection of claims 23, 43, and 56.

IV. Claim Rejections - 35 USC § 103(a)

Claims 70, 72, and 74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wu in view of Gill and further in view of U.S. Patent No. 5,446,854 issued to Khalidi et al. (hereinafter Khalidi.) Applicants respectfully traverse.

The final Office action concedes that Wu and Gill do not disclose the claimed limitations of claims 70, 72, and 74 yet cites to Khalidi and alleges that Khalidi discloses these additional limitations of claims 70, 72, and 74. Applicants respectfully submit that regardless of whether or not Gill discloses these additional limitations, claims 70, 72, and 74 are believed to be allowable over Wu and Gill because of their indirect dependency from the base independent claims 23, 43, and 56 and further because of the final Office action does not rely on Gill in supporting the basis for rejection of claims 23, 43, and 56.

CONCLUSION

Based on the foregoing, all claims are believed allowable, and an allowance of the claims is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below.

Applicant(s) hereby explicitly retracts and rescinds any and all of the arguments and disclaimers presented to distinguish the prior art of record during the prosecution of all parent and related application(s)/patent(s), and respectfully requests that the Examiner re-visit the prior art that such arguments and disclaimers were made to avoid.

The Commissioner is authorized to charge any fees due in connection with the filing of this document to Vista IP Law Group's Deposit Account No. 50-1105, referencing billing number 7035722001. The Commissioner is authorized to credit any overpayment or to charge any underpayment to Vista IP Law Group's Deposit Account No. 50-1105, referencing billing number 7035722001.

Respectfully submitted,

Date: March 09, 2009

By: /Erich C. Tzou/
Erich C. Tzou
Registration No. 56,927

VISTA IP LAW GROUP LLP
1885 Lundy Ave., Suite 108
San Jose, CA 95131
Telephone: (408) 321-8663 ext. 205
Facsimile: (408) 877-1662